

### *Status of the claims*

Claims 1-24 and 26-38 are pending in the application. Claims 30 and 37 have been amended more particularly to point out and distinctly claim the present invention. Claims 1, 16, 27, 28, 29, 31, and 38 are independent.

### *Requested action*

Applicants respectfully request the Office to reconsider and withdraw the outstanding rejections in view of the foregoing amendment and the following remarks.

Applicants also respectfully request that this amendment be entered. This amendment could not have been presented earlier as it was earnestly believed that the claims on file would be found allowable. Given the examiner's familiarity with the application, applicants believe that a full understanding and consideration of these amendments would not require undue time or effort by the examiner. Moreover, for the reasons discussed below, applicants submit that these amendments place the application in condition for allowance. At the very least, they are believed to place the application in better form for appeal. Accordingly, entry of this amendment is believed to be appropriate and such entry is respectfully requested.

### *Formal Objection*

Claim 37 is objected to because of a minor informality therein. In response, while not conceding the propriety of the objection, Claim 37 has been amended to address the points raised by the Examiner.

*Substantive rejections*

Claims 1-6, 8-14, 16-23, 27-31, and 38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the patent to Judson in view of the patent to Yoda. Claim 15 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the a patent to Judson in view of the patent to Yoda, and the publication to Brown. Claims 7, 26, and 32-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the patent to Judson in view of the patent to Yoda, and the patent to Hayashi, et al.

*Response to substantive rejections*

These rejections are respectfully traversed for the following reasons.

Independent Claim 1 relates to a method of forming a printable document by collating a plurality of hyper-text documents. The method comprises the steps of monitoring a user's access patterns to the hyper-text documents, accessing the hyper-text documents including structure information of the accessed hyper-text documents, compiling a list of the hyper-text documents using the structure information, and formatting the list into the printable document comprising each hyper-text document specified in the list.

In contrast, neither the Judson patent, nor the Yoda patent discloses or suggests the concept of formatting a list of hyper-text documents, compiled using structure information of the hyper-text documents accessed by a user by monitoring the user's hyper-text-document access patterns, into the printable document comprising each hyper-text document specified in the list, as recited by Claim 1.

Rather, the Judson patent merely teaches a method by which some useful information of a previously accessed web page can be temporarily displayed to a user from a cached

version of that web page while a currently accessed web page is being linked and downloaded for displaying. Before downloading of the currently accessed web page is completed, the useful information from the previously visited web page is productively displayed to both the user and the content provider. Such “useful information” are not hyper-links but “... may include, without limitation, advertisements, messages, fill-in forms, notices from a service provider, notices from another Internet service provider (such as receipt of an e-mail message), or some third party notice.” (See Judson col. 2, lines 1-4).

Further, as explicitly stated in this Abstract, Judson provides for the (temporary) display of a previously cached version of the data being downloaded. Such an operation does not involve forming a list of data to be displayed, but merely accesses a cached document via the currently active URL. Further, at best, such an operation results in a single printable document corresponding to the single active URL. Such an arrangement is entirely silent of, and offers no suggestion of, forming a printable document from multiple hyper-text documents as those documents are accessed.

The Yoda patent describes an arrangement by which a list of hyper-links is created from a single source document. These links are then used to obtain access to information, which is separately and linearly printed. Consequently, the Yoda patent discloses “... designating a print operation of desired first document information ... extracting link information indicating second document information ... printing the first document information and the second document information” (see Yoda col. 3, lines 14-27). Thus, this excerpt clearly shows that the Yoda patent relates two documents without formatting a list of hyper-text documents, compiled using structure information of the hyper-text documents accessed by a user by monitoring the user’s hyper-text-document access

patterns, into the printable document comprising each hyper-text document specified in the list, as recited by Claim 1. Instead, the Yoda patent merely prints multiple documents, each of which happens to be sourced from a single (parent) document.

Further, Figs. 2, 3, and 4 of Yoda clearly show that any second document described in the Yoda patent is directly linked to a first document (the single source document). As such, only information from the first document and the second document are printed. This is further reiterated in Yoda by "... document information which is linked to the base document information in two ways is specified, and only the specified document information is printed." (Col. 6, lines 51-53). Even so, the information in the Yoda patent is printed separately by "assigning serial page numbers to the first document information and the second document information" (Col. 3, lines 26-28). These statements extracted from the Yoda patent clearly show that printing "... a hypermedia document in a format that a user can easily understand ..." as referred to on page 7 of the final Office Action incorporates page numbering to distinguish and separate different pages respectively extracted from the first document information and the second document information. Therefore, the patent to Yoda does not teach or suggest, for example, forming a printable document by formatting a list into a printable document comprising each hyper-text document specified in the list, as recited by Claim 1. In fact, by formatting information from different documents into separate document pages, Yoda teaches away from the present invention as claimed in Claim 1.

The failure of these references to disclose or suggest at least this feature proves fatal to establishing a prima facie case of obviousness against Claim 1, since MPEP §2142, requires that:

To establish a prima facie case of obviousness... the prior art reference (or references when combined) must teach or suggest all the claim limitations.

For this reason, independent Claim 1 is allowable over the patents to Judson and Yoda.

Since independent Claims 16, 27, 28, 29, 31, and 38 recite similar features, they are allowable for similar reasons.

Thus, the Judson and Yoda patents do not disclose or suggest a method of forming a printable document by collating a plurality of hyper-text documents comprising the step of collating and formatting accessed hyper-text documents using structure information and at least a predetermined printable document format to form a printable document in which the accessed hyper-text documents are contiguously arranged therein over at least one printable page, as recited by amended Claim 16.

The Judson and Yoda patents, therefore, also do not disclose or suggest a computer implemented method for forming a printable document by collating a plurality of documents obtained from a plurality of sources comprising the step of collating selected documents according to a predetermined order of collating to form a printable document, the collating comprising arranging at least one display page according to a size of each selected document based upon corresponding structure information wherein the printable document is reproducible by at least by printing, as recited by amended Claim 27.

Consequently, the Judson and Yoda patents do not disclose or suggest means for monitoring access to documents via a resource locator and compiling a list of accessed ones of the documents, the list including corresponding links and structure information pertaining to each accessed document, and means for collating the list into a selected order

and for formatting the accessed documents within the list into a single printable document having at least components corresponding to the accessed documents arranged in the selected order, as recited by amended Claim 28.

Thus, the Judson and Yoda patents do not disclose or suggest a computer readable medium including instruction modules comprising a collating module for collating selective ones of documents from a compiled list into a single printable document in which each selected document is formatted according to structure information derived from monitoring browsing operations and a printing module for causing a printing of the single printable document thereby causing hard copy reproduction of the single printable document and the selected documents, as recited by amended Claim 29.

As a result, the Judson and Yoda patents do not disclose or suggest a computer program product having a computer readable medium having a computer program recorded thereon for forming a printable document by collating a plurality of hyper-text documents, comprising means for compiling a list of selected ones of the hyper-text documents using structure information of the documents and means for formatting the list into a printable document comprising the selected ones of the accessed hyper-text documents, as recited by amended Claim 31.

Finally, the Judson and Yoda patents do not disclose or suggest a computer implemented program for forming a single printable document by collating a plurality of hyper-text document, the method comprising the steps of fetching hyper-text documents accessed by a first application including corresponding structure information thereof and creating a single formatted printable document version of the accessed hyper-text documents, as recited by new independent Claim 38.

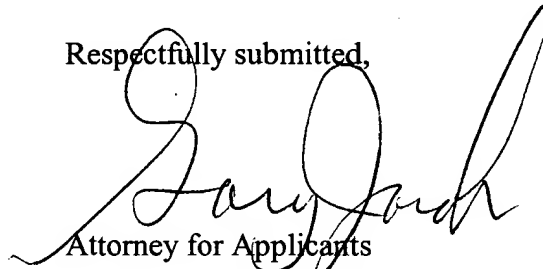
The dependent claims are allowable for the reasons given with respect to the independent claims and because they recite features which are patentable in their own right. Individual consideration of the dependent claims is respectfully solicited.

The other art of record is also not understood to disclose or suggest the inventive concept of the present invention as defined by the claims.

In view of the above amendments and remarks, the claims are now in allowable form and entry of this amendment is considered proper. Therefore, early passage to issue is respectfully solicited.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



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MARKED-UP VERSION OF AMENDED CLAIMS

30. (Amended) A medium as claimed in claim 29 [30] wherein said medium is one of a computer network, a hard disk, a floppy disk and an optical disk.

37. (Amended) A method according to Claim 35, wherein the hyper-text documents are formatted within the plural ones of the columns in such a manner to continuously reasonably fill each of the [column] columns whereupon a non-fitting remainder of the hyper-text document is formatted at least into an immediately succeeding column of the printable document.